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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91193335
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

EMBARCADERO TECHNOLOGIES, INC.

Opposer

v.

RSTUDIO, INC.

Applicant.

Opposition No.: 91-193,335

Trademarks: RSTUDIO

Serial Nos.: 77/691,980

77/691,984

77/691,987

OPPOSER’S OPPOSITION TO APPLICANT’S MOTION TO AMEND APPLICATIONS

On November 10, 2010, Applicant, RStudio, Inc. (hereinafter “Applicant”) filed a Motion to Amend Applications, seeking to amend the descriptions of goods and services for all three applications opposed in this proceeding. Opposer objects to and opposes said motion as inappropriate, untimely, and contrary to the applicable TTAB rules.

By its Order of November 29, 2010 the Board deferred consideration of Applicant’s Motion to Amend until final hearing, in accordance with ordinary Board practice. Opposer concurs with that deferral, but for completeness of the record sets forth herein its formal opposition to the motion, and formally urges that Applicant’s motion ultimately be denied.

Prefatory Note:

As a prefatory note, Opposer points out that the motion to amend is, in reality, not a motion to amend at all. Applicant moves to amend ONLY “*in the event that the Board deems such amendments necessary to dismiss the opposition*”. In essence, Applicant is not seeking to amend - instead, it is leaving it to the Board to decide whether the Board would be prepared to dismiss the opposition IF Applicant amends, and in that case - and apparently only in that case - Applicant leaves it up to the Board to decide if the conditionally proffered amendments should be entered. This is indeed an odd form of motion, and one which the Board should not grant or even consider under any circumstances.

A. Applicant's Motion is Contrary to Trademark Rules and Should be Denied

The TBMP expressly states that

An application involved in a proceeding may not be amended in substance nor may a registration be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or except upon motion.

37 C.F.R. § 2.133(a); TMBP § 514.03. Opposer did not and does not consent. Additionally, even if an amendment to an application is requested via motion, unconsented motions to amend that affect the issues in the proceeding are disfavored and typically denied by the Board. TBMP § 514.03¹. Here, Applicant's Motion to Amend the Applications not only is an unconsented amendment in substance, within the meaning of Trademark Rule 2.133(a), but also significantly affects core issues in this opposition. As such, the Motion should be denied.

1. Applicant's Motion is an Amendment "In Substance" as it Affects Core Issues in the Proceeding

Trademark Rule 2.133(a) disallows amendments "in substance" "except with the consent of the other party and the approval of the Board, or except upon motion," as such amendments drastically affect the core issues of the proceeding. *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433 (TTAB 2007) [precedential]. Here, Applicant claims - incorrectly, Opposer submits - that the proposed amendments merely "serve to clarify and limit but in no way broaden the identification of goods and services." Applicant's Mot. To Amend at 3. However, even assuming Applicant's proposed amendments do, in fact, clarify and limit the goods and services, the requested amendment constitutes an impermissible amendment "in substance" within the meaning of Trademark Rule 2.133(a). The Board noted in *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986) that

¹TBMP § 514.03 states "an unconsented motion to amend which is not made prior to trial, and which, if granted, would affect the issues involved in the proceeding, normally will be denied by the Board unless the matter is tried by express or implied consent of the parties pursuant to Fed. R. Civ. P. 15(b)".

Where, as here, a claim of likelihood of confusion has been pleaded, it will be the case . . . that any proposed amendment to an identification of goods in an application involved in a proceeding before the Board is an amendment “in substance” under Trademark Rule 2.133, and thus requires approval by the Board.

(Emphasis added). Here, Applicant’s proposed amendment is far more than merely clarification. Applicant, instead, proposes very significant and substantive amendments to the goods and services of each of the opposed applications, and does so not out of clarification, but rather in an effort to avoid the proceeding entirely. [Again, Applicant does not actually propose the amendments - Applicant conditionally proposes that the Board should enter such amendments as “the Board deems ... necessary to dismiss the opposition”.]

This opposition here is based principally on claims of likelihood of confusion, Notice of Opposition ¶¶ 7-9, as well as a lack of bona fide intent to use the mark on all of the listed goods and services at the time of filing. *Id.* ¶ 11. As stated above, the Board has previously held that any amendment in a likelihood of confusion case will be seen as an amendment “in substance”, and one that affects the core issues. *Giant Food, supra*. The Amendments proposed by the Applicant clearly fall within this category, as Applicant is hoping that with these amendments the claim of a likelihood of confusion between Opposer’s mark and Applicant’s mark when used on the carefully (and conditionally) revised goods and services will be moot, thus affecting a core issue in the proceeding.

Applicant’s purpose in proposing these amendments is not merely the outward stated motivation to “accurately convey the goods and services that Applicant offers and intends to offer in conjunction with the mark RSTUDIO,” Applicant’s Mot. To Amend Apps at 3, but an attempt to defeat the opposition in its entirety by any means possible. However, Applicant cannot defeat the likelihood of confusion claim through the proposed amendment to the applications, and cannot escape the fact that the amendment would be “in substance”. The Board has stated that in order to allow a proposed amendment in a likelihood of confusion proceeding, “an applicant seeking to

amend its identification of goods or recitation of services must set forth adequate reasons for the amendment.” *Drive Trademark Holdings, supra*. Applicant has made no attempt whatsoever to establish a prima facie case that the proposed amendments will change the nature and character of its goods, or restrict the channels of trade and purchasers such that there is no possibility of a likelihood of confusion, *See Drive Trademark Holdings, supra*. Instead, the attempt belies the outward motivation to secure a legitimate mark to protect Applicant’s interests - if and only if the Board is prepared to dismiss the opposition with those conditional amendments. Nothing in Applicant’s Motion to Amend Applications explains how the amendments “serve to clarify and limit . . . goods and services”, and there is no evidence offered to support such a claim.

Additionally, Applicant’s attempt to amend the applications at this point to those few goods and services for which Applicant apparently now claims a bona fide intent to use the marks also affects the core issues of the proceeding. It also raises serious questions about Applicant’s bona fide intent in initially applying for those broader goods and services. It may even be seen as a concession of an overly broad application, and possibly even that the marks may have been applied for fraudulently. Applicant applied originally for much broader coverage than is now being proposed. As these limitations arise only because of Opposer’s opposition to the three applications, Applicant may well have conceded and admitted to a lack of bona fide intent to use the marks at the time of filing as to each and every item of goods and services. If that is not the case, it sheds light on Applicant’s motives behind the current conditional - but highly unusual - offer to let the Board decide if limiting the goods and services would allow dismissal of the opposition.

Because such inappropriate tactics are unfortunately prevalent, the Board has previously held that any amendment in a likelihood of confusion case will be seen as an amendment “in substance”, and one that affects the core issues. Therefore, as Applicant’s proposed amendments drastically alter the goods and services in such a way as to attempt to avoid the likelihood of confusion claim as well

as the lack of bona fide intent to use claim, this amendment is “in substance”. Without the consent of the Opposer, as discussed below, such amendments are highly disfavored and should be denied.

2. Applicant’s Motion was made without the Consent of the Opposer

As stated above, Motions to Amend Applications made without consent from the other party are highly disfavored by the Board. The Board has held that the “Opposer has a right to a determination of the issues based on the identification of services of the mark as it was published for opposition” *Peopleware Sys., Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985). Additionally, The Board has gone on to further clarify that point in situations akin to the immediate proceeding, holding that

where a party objects to a proposed amendment to the applicant’s identification of goods, the conditions developed by the Board for balancing the competing interests of the parties and which were ‘the reasons set forth by the opposer’ for its objection to the motion to amend, must be satisfied *before* amendment will be permitted.

Id. (emphasis added). Opposer’s opposition is based upon the overly broad coverage indicated in Applicant’s original applications. By attempting to limit the coverage at this point through motion instead of through a settlement agreement or, ultimately, by Board Order, Applicant may simply be seeking to preserve an opportunity to refile for the broader range of goods and services at a later date. Opposer has declined to consent to other proposals by Applicant to limit its goods and services, and while Applicant had never approached Opposer with these specific amendments before filing the motion, Opposer specifically refuses to consent to these proposed amendments. This or any similar such amendment would be an amendment “in substance” and would significantly and substantively affect the core issues in this proceeding.

As Applicant’s proposed amendments are amendments “in substance” under Trademark Law 2.133(a), and Opposer has clearly and repeatedly objected to proposed amendments “in substance”, Applicant simply cannot overcome these high hurdles that would allow such amendments to be made over Opposer’s objections.

B. Even if the Amendment is Granted, a High Likelihood of Confusion Remains.

As discussed above, Applicant has not even attempted to make the required prima facie showing that the proposed amendments change the nature and character of Applicant's goods and services or restricts their channels of trade and purchasers such that a substantially different issue is presented for determination in this proceeding. However, even if Applicant is allowed to make such a showing, it would be unsuccessful as a high likelihood of confusion would exist even if the amendments were allowed. Consumers do not shop for and select goods and services with copies of trademark registrations in hand - no consumer actually studies individual registrations and/or applications to identify the source of goods or services. Moreover, it is axiomatic that it is not necessary that goods or services be identical or even competitive in order to support a holding of likelihood of confusion. It is beyond question that it is sufficient to establish likelihood of confusion where there is a relationship or association between the goods or services such that a consumer would assume that they originated from the same source. Here, both Opposer does and Applicant will market computer software for use in an integrated development environment. Limiting Applicant's applications to only the R language does not eliminate the fact that the products and services are still within the same market of "computer software and related services", and nothing excludes Opposer from using the R language in its products and services. Nothing divides the universe of customers by computer language - indeed, the evidence will show that most - if not all - software professionals are conversant in and use multiple languages, and will use new ones as they come along to the extent they are useful. Applicant will be unable to provide any evidence to establish that the use of the R language is a mutually exclusive line of business from other languages, or from the extensive software offerings of Opposer.

Moreover, the fact that Applicant's and Opposer's marks are nearly identical aids in finding likelihood of confusion regardless of whether the proposed amendments to Applicant's goods and services are accepted or not. The Board has consistently held that the greater the similarity of the

marks, the lesser the degree of similarity between the goods/services necessary to support a likelihood of confusion finding. *See Riviana Foods Inc. v. Romero-Nunez*, Opposition 91167098 (July 24, 2007) [not precedential]. *See also Cooper Industries, Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81 (TTAB 1983) and *Merritt Foods v. Associated Citrus Packers, Inc.*, 222 USPQ 255 (TTAB 1984). Here, Applicant's mark RSTUDIO merely removes the first letter of Opposer's mark ER/STUDIO. As the two marks are virtually visually, phonetically, and conceptually identical, it is again axiomatic that the degree of similarity in the goods need not necessarily be as pronounced to find a likelihood of confusion as it would have to be where there is more of a difference in the marks.

C. Opposer Agrees With The Board's Order Defering Consideration of the Motion until Final Determination.

Under the cases cited in the Board's Order of November 29, 2010 and also *Space Base, Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990), Opposer concurs with the Board's decision to defer consideration of Applicant's Motion to Amend Applications until final hearing.

WHEREFORE, in light of Opposer's arguments above, Opposer respectfully requests that Applicant's Motion to Amend Applications be denied.

Dated: November 30, 2010

Respectfully submitted,
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO AMEND APPLICATIONS** is being served on November 30, 2010, by first class mail, postage prepaid on Applicant's Attorney of Record at his address below (with courtesy copies sent by e-mail):

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